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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,074	11/29/2004	Dieter Rodewald	261968US0PCT	9656
22850	7590	12/05/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COONEY, JOHN M	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/516,074

Applicant(s)

RODEWALD ET AL.

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,8-16,18 and 19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5,8-16,18 and 19 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

Applicant's arguments filed 9-27-05 have been fully considered but they are not persuasive.

Rejection over Lekovic et al. is withdrawn in light of applicants' cancellation of claim 17.

Applicants' comments regarding claim 19 are in error. Claim 19 is actually broader in scope rather than narrower in scope than claim 1. Claim 19 is open to the inclusion or exclusion of "at least one polyether alcohol or polyester alcohol". Claim 1 is particularly limited to the inclusion of "at least one polyether alcohol or polyester alcohol".

Claim 18 is not further limiting of claim 1 as claim 18 is only further defining one of the potentially selectable species from the Markush group of claim 1.

The following rejections are maintained as set forth below accounting for amendments and additions to the claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 8-16, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Bruchmann et al.(6,696,505).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Bruchmann et al. disclose preparations of polyurethanes prepared from polyisocyanates and polyols based on hydroxyl-functionalized and non-hydroxyl-functionalized acrylate copolymers as claimed such that anticipation of the products and processes claimed is evident (see the entire document).

New claims 18 and 19 are fully addressed by address of claim 1.

Applicants' arguments have been considered but rejection is maintained for all of the reasons set forth above.

Bruchmann et al. discloses xylylene diisocyanate to be a conventional polyisocyanate used in the practice of their invention (column 4 line 47). Applicants' own claim 13 particularly recites this isocyanate to be a species of polyisocyanate used

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in the practice of their invention. Accordingly, this feature is not seen to be a distinguishing feature of applicants' claimed invention over the teachings of Bruchmann et al.

Claims 1-5, 8-13, 16, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Daumiller et al. (3,314,901).

Daumiller et al. disclose preparations of polyurethanes prepared from polyisocyanates and polyols based on hydroxyl-functionalized and non-hydroxyl-functionalized acrylate copolymers as claimed such that anticipation of the products and processes claimed is evident. (see column 1 line 43 – column 6 line 40, as well as, the entire document).

New claims 18 and 19 are fully addressed by address of claim 1.

Applicants' arguments have been considered but rejection is maintained for all of the reasons set forth above.

Applicants' claims do not exclude the required tertiary nitrogen group containing compounds of Daumiller et al. Accordingly, this feature is not seen to be a distinguishing feature of applicants' claimed invention over the teachings of Daumiller et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daumiller et al. as applied to claims 1-5, 8-13,16, 18 and 19 above, and further in view of Priester, Jr. et al.(4,931,487).

Claims differ from Daumiller et al. in that modification of the isocyanates is not particularly recited. However, the modification of isocyanates used in the synthesis of polyurethanes with groups, such as uretonimine and carbodiimide groups, is well known for the expected effect of variations in physical and reactive characteristics of the isocyanate reactant, such modification of isocyanates is recognized by, for example, Priester, Jr. et al. Accordingly, it would have been obvious for one having ordinary skill in the art to have modified the isocyanates of Daumiller et al. in the manner set forth by Priester, Jr. et al. with expectation of success in order to arrive at the products and processes of applicants' claims in the absence of a showing of new or unexpected results.

Applicants make no arguments in specific address of this rejection. Accordingly, no further comment is made herein.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8-16, 18 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S.

Patent No. 6,696,505. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 6,696,505 set forth preparations of polyurethanes prepared from polyisocyanates and polyols based on hydroxyl-functionalized and non-hydroxyl-functionalized acrylate copolymers.

Differences residing in variations in properties as claimed are attributable to variations in the components employed by the claims such that the variations in resultant products would have been obviously arrived upon by the ordinary practitioner in the art having before him the teachings of the claims of 6,696,505 and its claim defining disclosure.

Applicants' arguments have been considered, but rejection is maintained for the reasons set forth above. Looking to the specification of 5,696,505 for definition of the

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polyisocyanates of 5,696,505's claim 1 would reveal xylylene diisocyanate.

Accordingly, rejection is maintained to be proper as set forth above.

Claims 1-5, 8-16, 18 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-17 of copending Application No. 10/469,846. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 10/469,846 set forth preparations of polyurethanes prepared from polyisocyanates and polyols based on hydroxyl-functionalized and non-hydroxyl-functionalized acrylate copolymers. Differences residing in variations in properties as claimed are attributable to variations in the components employed by the claims such that the variations in resultant products would have been obviously arrived upon by the ordinary practitioner in the art having before him the teachings of the claims of 10/469,846 and its claim defining disclosure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejection is maintained as set forth above. Applicants' have acceptably made no arguments in address of this rejection at this time.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

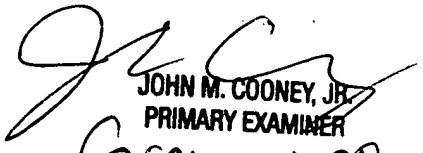
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JOHN M. COONEY, JR.  
PRIMARY EXAMINER  
Group 1700